

REMARKS

Claims 1-25 are pending in the present reissue application. Applicant gratefully acknowledges the Examiner's allowance of claims 1-20. Claims 21-25 presently stand rejected under 35 U.S.C. §§ 112 and 251.

As an initial matter, Applicant would like to thank the Examiner for the telephonic interview conducted May 22, 2001. It is respectfully submitted that claims 21-25 are in condition for allowance in view of the amendments and remarks presented herein, and their reconsideration and allowance is respectfully requested.

Claim 19 has been amended to correct typographical and clerical errors. Specifically, the misspelled word "ells" has been corrected to "cells," and the word "said" has been added to precede the phrase "second class of cells" in line 6 of the claim to specifically refer to a particular "second class of cells" introduced earlier in the claim.

Rejection under § 112, 2nd Paragraph

In the Office Action (Paper No. 2) mailed January 25, 2001, claims 22 and 24-25 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the claim dependencies were not clear because the limitations recited in dependent claims 22 and 24-25 do not appear in the independent claims 17 and 19 from which they were identified to depend, respectively. Applicants respectfully traverse this rejection.

Applicant thanks the Examiner for pointing out this clerical error in the application as filed. Claims 22 and 24-25 have been amended to depend from claims 21 and 23, respectively, as originally intended. Applicants note that claim 21 recites the "multiple user wireless communication system" limitation referred to in claim 22, and that claim 23 recites the "wireless communication system" limitation referred to in claims 24-25.

In amending claims 22 and 24-25, Applicant respectfully submits that this amendment is not made for purposes of narrowing the scope of claims 22 or 24-25, but rather to particularly point out and distinctly claim the subject matter which applicant regards as the invention per 35 U.S.C. § 112, second paragraph.

Rejection under 35 U.S.C. § 251

In the Office Action (Paper No. 2) mailed January 25, 2001, claims 21-25 were rejected under 35 U.S.C. § 251 as broadened claims allegedly improperly presented in a reissue application made and sworn to by the assignee and not the patentee.

However, Applicant respectfully submits that a proper "Reissue Application Declaration by the Inventor," PTO Form PTO/SB/51, executed by the inventor/patentee Robert C. Dixon on April 5, 2000, was submitted along with the application at the time of its filing. Applicant herewith submits the following in support: 1) A copy of the as-filed declaration made and sworn to by the inventor, bearing notation identifying its filing via U.S.P.S. Express Mail Label No. "EL524788042US," 2) A copy of the Express Mail Label No. "EL524788042US," showing a "Date In" of June 14, 2000, and 3) A copy of the Return Receipt postcard for the application filing contents filed via U.S.P.S. Express Mail Label No. "EL524788042US," including the "Declaration by the Inventor," bearing the USPTO filing date of June 14, 2000 and assigning Application No. 09/595,557 to the subject application.

Therefore, Applicant respectfully submits that a proper declaration made and sworn to by the inventor has been made in the application in compliance with applicable rules and regulations and 35 U.S.C. § 251, and requests that this rejection be withdrawn.

Recapture Rule Bar

The Office Action also asserts that the recapture rule bars reissue claims 21-23 and 24-25 because the claims are broader than canceled or amended claims in the previous patent in all aspects. Applicant respectfully traverses this rejection.

Application of the recapture rule requires a two-part inquiry. *In re Clement*, 131 F.3d 1464, 1468 (Fed. Cir. 1998). The first step is to determine whether and in what aspect the reissue claims are broader than the patent claims. *Id.* The second step is to determine whether the broader aspects of the reissue claims were surrendered during prosecution of the patent. *Id.* Surrender requires that limitations to the broadened aspects added to the claims of the patent during its prosecution be made in order to overcome a rejection made over prior art. *Ex parte Danby*, 58 USPQ2d 1093, 1096 (BPAI, July 7, 2000).

Applicant respectfully submits that, contrary to the position asserted in the Office Action, claims 21-25 of the instant reissue application are not broader than the patent claims in all aspects. Rather, a broadened aspect of reissue application claims 21-25 (with respect to the patent claims) is that claims 21-25 do not require base stations in adjacent cells to be assigned different frequencies for communication, nor are user stations in adjacent cells required to be assigned different frequencies for communication.

Regarding this broadened aspect, claim 1 of Application No. 08/876,775 (which matured into U.S. Patent No. 5,850,600, hereinafter "the patent") was canceled without prejudice or disclaimer at the time of the filing of Application No. 08/876,775. Notwithstanding other differences in scope between canceled claim 1 of Application No. 08/876,775 and claims 21-25 of the instant reissue application, canceled claim 1 of Application No. 08/876,775 also did not require base stations in adjacent cells to be assigned different frequencies for communication, nor did that claim require user stations in adjacent cells to be assigned different frequencies for communication. However, Applicant can find no indication in the prosecution history that the subject matter of reissue claims 21-25 was canceled or amended to require base stations in adjacent cells to be assigned different frequencies for operation in order to overcome a prior art rejection. If Applicant is in error in this respect, the Examiner is invited to cite to the prosecution history wherein such argument or amendment was made. Further, if the Examiner provides such citation to the prosecution history wherein such argument or amendment was made, Applicant respectfully requests such citation to be made in the form of a NON-FINAL Office Action in order for Applicant to reply in response on the merits.

In summary, Applicant has not identified any argument or amendment made to the claims of the patent during its prosecution that would constitute recapture of surrendered subject matter as recited in reissue application claims 21-25, as these claims are not broader in an aspect related to a prior art rejection. Nothing has been identified in the prosecution history to indicate that Applicant or the Examiner considered the limitations to the broadened aspects necessary to overcome prior art. *Danby*. Therefore, Applicant respectfully submits that the recapture rule does not bar claims 21-25, and respectfully traverses this rejection.

Request for Allowance

In view of the foregoing amendments and remarks, it is respectfully submitted that claims 1-25 of the present reissue application are in condition for allowance, and reconsideration and allowance of the present reissue application is earnestly solicited.

A one-month extension fee of \$110 is included herewith. Should it be determined that any additional fee is required in connection with this response, the Commissioner is hereby authorized to charge any fees necessary in connection with this amendment and response to Lyon & Lyon LLP's Deposit Account No. 12-2475. A duplicate copy of this authorization is provided for accounting purposes.

Should the Examiner have any questions concerning this amendment and response, she is invited to contact the undersigned at (202) 974-6017 who will cooperate to move the case forward.

Respectfully submitted,

LYON & LYON LLP

Dated: May 25, 2001

By: 

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS

Please amend the claims as follows:

Claim 19, line 2, replace "ells" with "cells".

Claim 19, line 6, after "no member of" insert "said".

22. (Amended) The multiple user wireless communication system of claim [17]21, wherein said base station communicates with said user stations using time division duplexing.

24. (Amended) The wireless communication system of claim [19]23, wherein said base station is assigned a first set of one or more distinct spreading codes for communicating with user stations in said first cell, said first set of one or more distinct spreading codes not being assigned to any base station for communicating in any cell in said plurality of cells adjacent said first cell, and wherein said user stations in said first cell are assigned a second set of one or more distinct spreading codes, said second set of one or more distinct spreading codes not assigned to any user stations in any cell in said plurality of cells adjacent said first cell.

25. (Amended) The wireless communication system of claim [19]23, wherein said base station communicates with said user stations using time division duplexing.